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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOC KET NO.	CONFIRMATION NO.
08/713,905	09/13/1996	FRANK RICHTER	MO-4532/LEA	2755

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PATENT DEPARTMENT  
BAYER CORPORATION  
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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 111703

Application Number: 08/713,905

Filing Date: 09/13/1996

Appellant(s): Richter et al.

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Lyndanne Whalen

For Appellant

MAILED  
NOV 20 2003  
GROUP 1700

EXAMINER'S ANSWER

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This is in response to the appeal brief filed August 25, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-4, with respect to the 35 U.S.C. 112 rejection, and the rejection of claims 1 and 2, with respect to the 35 U.S.C. 103 rejection, stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

3,267,122	Lehmann et al.	August 16, 1966
5,391,683	Joulak et al.	February 21, 1995
5,449,818	Biskup et al.	September 12, 1995
5,516,935	Bischof et al.	May 14, 1996

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Appellants have failed to provide adequate support for the range of values claimed for the hydrolyzable chlorine content. The examples provide support only for 24 ppm, 34 ppm, 43 ppm, 44 ppm, and 48 ppm. The position is taken that the examples do not provide support for values below 24 ppm or above 48 ppm or for ranges of values between the specified values.

Appellants have argued that the examiner's position is contrary to the CCPA's holding in In re Eickmeyer, 202 USPQ 655 (CCPA 1979). The examiner has reviewed the decision, and the

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position is maintained that the instant situation is not sufficiently analogous to the decision to support withdrawal of the rejection. The decision states that support for the temperature range also stemmed from the knowledge that elevated temperatures were known from analogous prior art systems. Contrary to appellants' argument, analogous support for the hydrolyzable chlorine content has not been provided in the instant case. Appellants' argument that this additional support can be found within the teachings at page 5, lines 19-21, where it is disclosed that the ether isocyanate may be isolated in pure form by known processes is deficient, because the argued passage lacks any specifics with respect to controlling the hydrolyzable chlorine content or what levels of hydrolyzable content differentiate a pure compound from an impure compound.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmann et al. ('122) in view of Joulak et al. ('683) or Biskup et al. ('818) or Bischof et al. ('935).

Lehmann et al. disclose the production of ether isocyanates by reacting phosgene with ether amines. See column 1, lines 42+.

Lehmann et al. are silent regarding conducting the process in the vapor phase; however, the secondary references disclose the phosgenation of diamines in the vapor phase with an attendant increase in yield, as compared to conventional phosgenation processes. Therefore, one

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of ordinary skill in the art seeking a method of producing ether isocyanates and improving yield would have been motivated to utilize the vapor phase phosgenation methods of the secondary references with the ether amines of Lehmann et al., so as to obtain ether isocyanates displaying greater purity and more economical processes.

In response to appellants' arguments, the examiner has again considered the declaration, filed September 30, 2002; however, the declaration is deemed to be insufficient to remove the art rejection. Declarer has stated that he would not have expected to be able to produce an ether (poly)isocyanate under the conditions required for gas phase phosgenation of the corresponding (poly)amine in view of the cleavage problem associated with ether isocyanates. To support his position, declarer cites passages from Annalen der Chemie; however, the cited passages do not appear to closely relate to aspects of vapor phase phosgenation; therefore, the passages and the relied upon vapor phase phosgenation processes of the secondary references lack the necessary nexus to establish a clear correlation between the claimed subject matter and the subject matter of the declaration. In the absence of such a correlation, the position is taken that the evidence of obviousness outweighs the evidence of nonobviousness.

**(11) Response to Argument**

Appellants' arguments have been addressed within the *Grounds of Rejection*.

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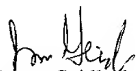
For the above reasons, it is believed that the rejections should be sustained.

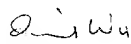
Respectfully submitted,

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sargent  
December 6, 2001

Conferees:

  
Supervisory Patent Examiner James Seidleck

  
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